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10/530,161	01/17/2006	Tomoko Enatsu	9683/236	7519

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EXAMINER	
KIM, HEE SOO	
ART UNIT	PAPER NUMBER
2157	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,161	ENATSU ET AL.	
	Examiner	Art Unit	
	Hee Soo Kim	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/1/05, 5/3/07, 8/27/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to application filed on April 1, 2005.

Claims 1-13 are pending examination.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 4/1/2005, 5/3/2007, 8/23/2007 was filed after the mailing date of 4/1/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are contradicting that e-mail should be sent even if it contains filtered keywords. For the purposes of examination, examiner as best understood interprets both claims as allowing the e-mail to be sent to the recipient addressee within the time period if keywords are **not** present in the message. Clarification is required to determine what applicant is attempting to achieve.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3~10, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Nitta (EP 1085436).

Regarding Claim 1,
Nitta taught a server apparatus comprising:

a. a receiving means for receiving an email (Col. 3, Par. [0015~[0016], Fig. 5);

b. a storage means for storing, in association with an email address, screening data for screening the email (Col. 3, Par. [0019]);

c. a determining means for determining an email address indicating an addressee from the email received by the receiving means (Col. 3, Par. [0019] ~[0021]),

d. reading from the storage means the screening data associated with the determined email address (Col. 3, Par. [0019] ~[0021]),

e. determining whether to deliver the email to the recipient addressee based on the read screening data (Col. 3, Par. [0019]~[0021]), and

f. outputting a determination result (Col. 6, Par. [0046]);

g. a reporting means for reporting information indicating the determination result to the determined e-mail recipient addressee if the determination result is "not deliver" (Col. 5, Par. [0043]~[0044], Fig. 7); and

h. a delivery means for delivering the received email to the determined email recipient addressee if the determination result is "deliver" (Col. 3, Par. [0032] ~[0034]).

Regarding Claim 3,
Nitta taught the reporting means reports the determination result to the sender of the received email when the email address determined by the determining means is a first email address (Col. 5, Par. [0043]~[0044], Fig. 7).

Regarding Claim 4,
Nitta taught the reporting means reports the determination result via email (Col. 5, Par. [0043]~[0044], Fig. 7).

Regarding Claim 5,
Nitta taught the receiving means stores the received email in the storage means (Col. 6, Par. [0048]~[0049], Fig. 8); and

the determining means deletes the stored email from the storage means, if the determination result is "not deliver" (Col. 6, Par. [0048]~[0049], Fig. 8).

Regarding Claim 6,
Nitta taught the determining means stores a history of the determination results in the storage means, in association with determined email address (Col. 6, Par. [0049]~[0050], Fig. 8); and

the reporting means reports the history of the determination results to the determined email address (Col. 6, Par. [0048]~[0049], Fig. 8).

Regarding Claim 7,

Nitta taught the storage means stores an order of priority in association with the delivery screening data and an order of priority in association with the non-delivery screening data, respectively, if the screening data includes both delivery screening data for screening email to be delivered and non-delivery screening data for screening email not to be delivered (Col. 5, Par. [0038], if the email fails both the transmission and discard conditions (contains both deliver and not delivered screening data), a request is made to the user giving priority whether the email should be downloaded. It is well-expected the user will mark the email to be "deliver" based on the decision made to the request allowing the determining means to deliver the mail to the inbox. On the other hand if the user chooses to not download the mail, the determining means will deliver the message to the junk list);

the determining means outputs the determination result "deliver", if received email contains only delivery screening data (Col. 3, Par. [0032] ~[0034]);

the determining means outputs the determination result "not deliver" if received email contains only non-delivery screening data (Col. 5, Par. [0043]~[0044], Fig. 7);

the determining means reads from the storage means the order of priority for the screening data contained in the received email if the screening data includes both delivery screening data and non-delivery screening data, and outputs the determination result "deliver" if the screening data with the highest order of priority is delivery screening data, and outputs the determination result "not deliver" if the screening data with the highest order of priority is non-delivery screening data (Col. 5, Par. [0038], if the email fails both the transmission and discard conditions (contains both deliver and not

delivered screening data), a request is made to the user giving priority whether the email should be downloaded. It is well-expected the user will mark the email to be "deliver" based on the decision made to the request allowing the determining means to deliver the mail to the inbox. On the other hand if the user chooses to not download the mail, the determining means will deliver the message to the junk list);

Regarding Claim 8,

Nitta taught the storage means stores for each email address the order of priority for delivery screening data and the order of priority for non-delivery screening data, respectively (Col. 5, Par. [0038], if the email fails both the transmission and discard conditions (contains both deliver and not delivered screening data), a request is made to the user giving priority whether the email should be downloaded. It is well-expected the user will mark the email to be "deliver" based on the decision made to the request, store the priority in the storage means, and allowing the determining means to deliver the mail to the inbox. On the other hand if the user chooses to not download the mail, the determining means will deliver the message to the junk list).

Regarding Claim 9,

Nitta taught the determining means outputs the determination result "deliver" if the screening data is contained in the received email (Col. 3, Par. [0019] ~[0021], e-mail is delivered if screening data is not present in the message. If the message contained screening data, the filter has failed to detect such message).

Regarding Claim 10,

Nitta taught the storage means stores one or more screening data candidates in association with category information (Col. 4, Par. [0031], downloading or discarding (categories) email conditions are set by user);

the server apparatus further comprises a sending means for sending information on a plurality of categories to a communication terminal capable of receiving email (Col. 4, Par. [0031], downloading or discarding (categories) email conditions are set by user. It is implicit the email server would need to provide the means to set the email conditions since the user inputs allow and discard conditions in the server);

the receiving means further receives an email address assigned to the user of the communication terminal and sent from the communication terminal along with the category information selected by the user of the communication terminal from among the information the plurality of categories sent by the sending means and sent from the communication terminal (Col. 4, Par. [0031], downloading or discarding (categories) email conditions are set by user. It is implicit to set the email conditions from the computer to limit unwanted junk mail received at the mail server addressed to the email address); and

the storage means stores, in association with the email address received by the receiving means, one or a plurality of screening data candidates associated with the category information received by the receiving means (Col. 4, Par. [0031], downloading or discarding (categories) email conditions are set by user. It is well-expected the email conditions are stored in the server as the whole point of filtering unwanted junk mail is to differentiate what is wanted and unwanted email to the destination address).

Regarding Claim 13,

Nitta taught a deleting means for deleting the screening data from the storage means (it is implicit screening data is deleted from the storage to allow further refinements in the filter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta (EP 1085436) in view of Aronson et al. hereinafter Aronson (US 6,654,787).

Regarding Claim 2,

Nitta did not explicitly teach the receiving means comprises

a clock means for obtaining a current time;

the storage means stores data indicating a trial period; and

the delivery means delivers the received email to the determined email recipient addressee while the current time obtained by the clock means is within the trial period, if the determination result is "not deliver".

However, Aronson taught an e-mail filter API with rule aging continually monitored by server determining whether the rule(s) has not been used to filter spam for a predetermined time. The rules may also be moved from an active to inactive state according to the type of spam received by the server (Col. 6, Lines 30~43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Nitta's system, Aronson's rule aging method to allow the rules filter e-mail messages based on their content. E-mails containing filtered keywords within the predetermined time period of the rules would filter the messages and not deliver to the recipient. The combination would allow the e-mail filter to continually be updated according to the types of spam being updated and filter all types of spam from reaching the recipient's inbox.

Claim Rejections - 35 USC § 103

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nitta (EP 1085436) in view of Aronson et al. hereinafter Aronson (US 6,654,787) and in further view of Sakaguchi et al. hereinafter Sakaguchi (US 6,199,103).

Regarding Claim 11,

Nitta and Aronson both did not explicitly teach the storage means stores screening data candidates, and

the storage means stores a screening data candidate, if the received email contains the screening data candidate in the case that the email address determined by the determining means is a second email address.

However, Sakaguchi taught an e-mail determination system where junk mail keywords are extracted for evaluation. The keywords stored in the junk email condition storage section are compared with the extracted keywords from the message. Based on the evaluation of the keywords, mails are sorted as junk or non-junk email. Extracted keywords are then stored in the junk email determination storage (Col. 6, Lines 35~Col. 7, Lines 1~42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Nitta and Aronson's system, a keyword extraction method to further allow the filtering of e-mail messages based on the keywords contained (offending or non-offending). The combination would allow the e-mail filter to continually be updated according to the types of spam being updated and filter all types of spam from reaching the recipient's inbox.

Regarding Claim 12,

Nitta and Aronson both did not explicitly teach the storage means stores screening data candidates, and

the determining means extracts a plurality of character strings from the received email by performing morphological analysis applied to the received email, compares

each of the plurality of extracted character strings with the screening data candidates stored in the storage means, and stores as screening data in the storage means the screening data candidate identical to the extracted character string, if the email address determined by the determining means is a second email address.

However, Sakaguchi taught an e-mail determination system where junk mail keywords are extracted for evaluation. The keywords stored in the junk email condition storage section are compared with the extracted keywords from the message. Based on the evaluation of the keywords, mails are sorted as either junk or non-junk email. Extracted keywords are then stored in the junk email determination storage (Col. 6, Lines 35~Col. 7, Lines 1~42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to implement, in Nitta and Aronson's system, a keyword extraction method to further allow the filtering of e-mail messages based on the keywords contained (offending or non-offending). The combination would allow the e-mail filter to continually be updated according to the types of spam being updated and filter all types of spam from reaching the recipient's inbox.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Patent 7,237,008, US Patent 7,058,684, US Patent 6,704,771, US Patent 7,203,749, US Patent 6,996,606, US Patent 6,233,322.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hee Soo Kim whose telephone number is (571) 270-3229. The examiner can normally be reached on Monday - Friday 8:00AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-5001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HSK
10/2/07

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